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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,519	06/05/2002	Burrrhus Lang	TRG-299	5973

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PEASE INTERNATIONAL TRADEPORT
PORTSMOUTH, NH 03801

EXAMINER

BOCKELMAN, MARK

ART UNIT	PAPER NUMBER
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3766

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/030,519	Applicant(s) LANG ET AL.	
	Examiner Mark W. Bockelman	Art Unit 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>4-20-2006</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-28,30-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Canadian patent 1,219,642.

Canadian patent 1,218,642 shows several embodiments of electrode configurations. In figure 3, 3 potential electrode elements 30, 33, 36 are shown that extend to a tab 32 with three uncontacted elements. The elements are each capable of being contactable by an electrode or can be consider "free" of a contacting element depending upon the intended use. Applicant's circular rings as shown in their drawings are all capable of being contacted by an electrical energy applicator. Thus, the examiner designates which elements are contactable in terms of intended use in interpreting applicant's claims. In claims 16-21, 23-28, 30 and 32 the examiner considers the contactable conductor to be electrode 30 and the uncontacted conductor to either elements 33 and/or 36. Regarding claims 22, the examiner considers the inner uncontacted conductor 33 to extend into the space between contactable conductors 30 and 36. Regarding claim 31, the examiner considers the conductors to be formed in alternative (interleaved) surfaces (figure 4) wherein starting with the most inner

conductor, every other conductor is contactable and the others are uncontacted. The method step would be inherent since the method does not require the uncontacted metal surface to remain unconnected to the electrical stimulator. If applicant were to amend the method claims to state that the uncontacted conductor is not connected electrically to the electrical stimulator during electrical stimulation the examiner would look favorably upon the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 29 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Canadian patent 1,219,642. It is unclear as to which figure, if any, applicant has drafted claim 29 to cover. It appears that applicant considers two radially spaced contactable electrodes to have "substantially equal" surface areas and peripheral lengths. Since radially spaced electrodes would have both their peripheral lengths and surface areas vary as a function of the radius, it would appear that "substantially equal" has a fair degree of latitude. In this respect, the examiner considers the hook configurations of the various conductors in figure 4 of

the Canadian reference to have "substantially equal" surface areas and peripheral lengths, and or it would have been obvious to modify the thicknesses of the electrodes to within such a range as an obvious design choice.

Response to Arguments

Applicant's arguments filed 4-19-2006 have been fully considered but they are not persuasive. The structure of the Canadian '642 is similar to applicant's and thus would have the same properties if used in the same way. The examiner considers the term "uncontacted" to be a negative intended use, and it would be inherent to connect the contacts one at a time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W. Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 10:00 to 6:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272 -6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3766

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MWB

May 19, 2006


MARK BOCKELMAN
PRIMARY EXAMINER